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10/534,454	12/13/2005	Friedrich Kastner	2005_0782A	4789
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EXAMINER				
INYARD, APRIL C				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
07/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/534,454

**Applicant(s)**

KASTNER ET AL.

**Examiner**

APRIL C. INYARD

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Examiner acknowledges amendments to the claims.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-20 are pending and have been considered as follows:

#### ***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Austria on November 28, 2002. The examiner will attempt to obtain a copy of the document from the international office.

#### ***Claim Rejections - 35 USC § 102***

5. **Claims 12-15 are rejected under 35 U.S.C. 102(b) as being unpatentable over Kaule:**

Kaule discloses a security type of label that can be designed as a label or transfer foil that can be cut to size and transferred from a separation layer on a carrier substrate and adhered via an adhesion coating onto an object ('221; Col 4, lines 43-53) to provide high counterfeiting security for a variety of objects to be protected, wherein such objects include documents of value, ID cards, passports, books, and compact discs ('221; Col 8, lines 37-43).

Kaule teaches use of UV-curable lacquers ('221; Col 6, lines 60-67; Col 7, lines 16-56) and that embossing of UV-curable lacquers is well-known in the security foil (i.e. hologram, cinegram, pixegram) art ('221; Col 1, lines 35-55). Kaule teaches that the UV-curable lacquer is cured completely via two UV lamps (Col 7, lines 15-29).

Kaule teaches that it is known in the art of making security features for application to objects to use UV-curable lacquers where surface features are provided by embossing while the lacquer is cured optionally provided with further functional layers followed by application of an adhesive coating and cutting to size (*'221; Col 1, lines 35-62; Col 8, lines 37-40*). Electronic data processors and scanners are used to align the desired printed pattern on the label (*Col 6, lines 42-56*).

Kaule teaches a hologram foil with negative writing wherein a carrier foil is coated with a lacquer, embossed with relief structures to provide a diffraction pattern where this embossed structure is subsequently filled in with ink or negatively-printed on, covered with a metal layer and treated to provide an optical holographic metallized security feature (*'221; Fig. 1; Col 6, lines 19-41*), where the carrier foil is defined as all kinds of materials such as plastics, metals or papers of any composition (*'221; Col 3, lines 60-64*). Holographic security features inherently exhibit chromatic tilt effects.

Regarding the limitation toward "deep-drawable", the Examiner notes that although Kaule does not specifically teach a "deep-drawable" lacquer, Kaule teaches a lacquer that is UV-curable. Kaule further teaches that the UV-curable lacquer is impressed by a mold to form features in the label, wherein the lacquer is only fully cured after an embossing step. The UV-lacquer of Kaule has a composition (UV-curable) and function (separation from carrier, embossed) as claimed by Applicant, the Examiner takes the position that the UV-lacquer will inherently have the deep-drawable properties as required by Applicant. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v.*

*Banner*, 227 USPQ 773. Applicant bears the responsibility for proving that the reference composition does not possess the characteristics recited in the claims. *In re Fitzgerald*, 205 USPQ 597, *In re Best*, 195 USPQ 430.

Kaule discloses that security features are may be applied to any object (*Col 8, lines 37-43*), but fails to specifically disclose that the security feature is 'for application onto a packaging film.' However, the limitation of 'for application onto a packaging film' is a statement of intended use, and must result in a structural difference between the prior art and the claimed intended use to be given patentable weight. MPEP 2111.02 II. No structural difference can be discerned between the prior art and the present claims.

Therefore Kaule teaches a method for producing security features, that are capable of being applied to a packaging film, wherein the security label features comprise the layered structure as required by the instant claims including a carrier substrate, a UV-curable separation lacquer, considered to be capable of being deep-drawn, that is cured completely after being embossed by a mold, which is subsequently provided with additional functional layers including printed ink and adhesive layers, and wherein said features are cut to size to be transferred to an object.

Therefore, Kaule teaches a method for the production of security features that meets the limitations of **Claims 12-15**.

6. **Claims 1-8 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule (WO/9956964; US Patent No. 6,688,221 B1, English equivalent) in view of Walter (4,146,418); or, alternatively, Walter in view of Kaule:**

Regarding **Claims 1 and 16**, as discussed above, Kaule teaches a security label feature with a layered structure that meets the limitations of Applicant's claimed structure.

Kaule discloses a security type of label that can be designed as a label or transfer foil that can be cut to size and transferred from a separation layer on a carrier substrate and adhered via an adhesion coating (**Claim 8**) onto an object (*'221; Col 4, lines 43-53*) to provide high counterfeiting security for a variety of objects to be protected, wherein such objects include documents of value, ID cards, passports, books, and compact discs (*'221; Col 8, lines 37-43*).

As discussed above, Kaule discloses that the security features may be cut to size and applied as a label or transfer foil (*Col 5, lines 44-53*) to an object (*Col 8, lines 37-43*). Kaule meets the structural limitations of the Applicant's claimed security features, but only teaches objects in general with applied security features.

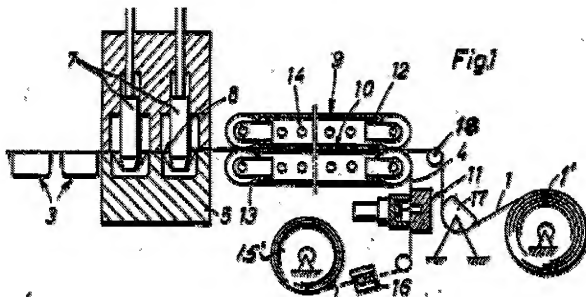
Kaule differs from the present invention in that Kaule does not specifically teach a packaging film with such security labels regionally applied or a method of applying said features to a packing film.

However, in a related art of labeling packaging materials that are subsequently shaped (in-mold labeling), Walter teaches a deep-drawn packaging material and process for making said material, wherein a label and a planar packaging film material are simultaneously laminated and deep-drawn to result in a three-dimensionally formed packaging material bearing a label that is fixedly secured on either one or two sides of the stamped cup-like shape formed as a result of the

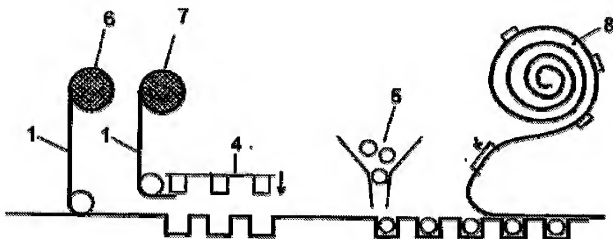
Art Unit: 1794

deep-drawing process (Fig. 1, Fig. 3, element 2 = label and related text; Abstract; Cols 1-2, lines 54-68 and 1-28);

Walter, Fig. 1:



Applicant's Invention, Fig. 2:



Walter teaches a method for applying labels to selected areas of a packaging material wherein the label tape is broken along pre-set breaking lines to form individual labels, which are

passed through a preheating section of the forming apparatus to join the label and packaging film portion and is subsequently formed into a shape by deep-drawing (*Fig. 1 and related text; Cols 1-2, lines 60-68 and 1-45*).

It would have therefore been obvious at the time the invention was made to one having ordinary skill in the art to modify the object to which the transfer foil security labels of Kaule are applied by substituting the general objects (documents of value, ID cards, passport, CDs) of Kaule with the packaging materials and process of in-mold labeling as taught by Walter because the labels of Kaule are capable of being applied to any variety of objects including packaging materials and because use of such security features in the in-mold process disclosed by Walter would result in a packaging material with a label that is fixedly attached and integral with the packaging material that has an intrinsically improved anti-counterfeiting and authenticating feature.

Thus, Kaule in view of Walter teach a packaging film and method for application of security features to a packaging film that meets the limitations of **Claims 1 and 16**.

Regarding **Claims 2-7**, Kaule teaches use of UV-curable lacquers ('221; *Col 6, lines 60-67; Col 7, lines 16-56*) and that embossing of UV-curable lacquers is well-known in the security foil (i.e. hologram, cinegram, pixegram) art ('221; *Col 1, lines 35-41*). Kaule teaches that the UV-curable lacquer is cured completely via two UV lamps (*Col 7, lines 15-29*).

Kaule teaches that it is known in the art of making security features for application to objects to use UV-curable lacquers where surface features are provided by embossing while the lacquer is cured optionally provided with further functional layers followed by application of an adhesive coating and cutting to size ('221; *Col 1, lines 35-62; Col 8, lines 37-40*). Electronic



data processors and scanners are used to align the desired printed pattern on the label (*Col 6, lines 42-56*).

Kaule teaches a hologram foil with negative writing wherein a carrier foil is coated with a lacquer, embossed with relief structures to provide a diffraction pattern where this embossed structure is subsequently filled in with ink or negatively-printed on, covered with a metal layer and treated to provide an optical holographic metallized security feature (*'221; Fig. 1; Col 6, lines 19-41*), where the carrier foil is defined as all kinds of materials such as plastics, metals or papers of any composition (*'221; Col 3, lines 60-64*). Holographic security features inherently exhibit chromatic tilt effects.

Regarding the limitation toward "deep-drawable", the Examiner notes that although Kaule does not specifically teach that the UV-curable lacquer is "deep-drawable", the Examiner takes the position that absence a showing of unexpected results, that the UV-curable lacquer of Kaule is capable of being deep-drawn, particularly given the teaching in Kaule that the UV-curable lacquer is impressed by a mold to form features in the label.

Regarding **Claims 4-6**, Kaule additionally teaches that the security feature may include one or several layers with electrical, magnetic, thermochromic, chromatic tilt (iridescent), luminescent, and other special properties (*'221; Col 4, lines 1-8*).

Regarding, **Claim 7**, Kaule further discloses that the embossed surface features of the security features, independently of the other functional properties (e.g. optical), can be used to impart patterns in the form of letters, symbols, geometric shapes and the like (*'221; Fig. 4; Col 8, lines 17-19 and 29-31*).

Alternatively, Walter teaches a packaging material and method for in-mold labeling of a packaging material as discussed above.

Walter does not specifically teach that the labels comprise security features.

However, as discussed above, Kaule teaches the formation of security features that meet the structural limitations of Applicant's instant claims that may be cut to size and transferred from a carrier foil to an object due to the separation UV-cured lacquer.

It would have therefore been obvious at the time the invention was made to one having ordinary skill in the art to modify the label on the in-molded packaging material and method as taught by Walter by substituting the label as taught by Kaule because this will yield an in-molded packaging material with a label that is fixedly attached wherein this label comprises unique security features that may include various optical effects and other properties which provide additional identifying and anti-counterfeit security to the in-molded packaging material.

**7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule in view Walter as evidenced Bitner et al. (US Patent No. 5,310,060):**

As discussed above, Kaule in view of Walter teaches a packaging film that meets the limitations of Claim 1.

Regarding **Claim 10**, Kaule in view of Walter fails to specifically teach that the film is cold-formable.

However, as evidenced by Bitner, cold-, thermo-, and pressure-forming are all equivalent conventional methods known in the art form forming blister and strip (blister sheet) packaging ( *Col 13, lines 55-60*).

The Examiner takes the position that the packaging material disclosed by Kaule in view of Walter is capable of being cold-formed, and therefore meets the limitations of the instant claim.

**8. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule in view Walter and Zeiter et al. (US Patent No. 6,494,491 B1):**

As discussed above, Kaule in view of Walter disclose a packaging film that meets the limitations of Claim 1, and specifically that the packaging film is a deep-drawn cup-like container type of film or package.

Regarding **Claims 9-10 and 20**, neither Kaule nor Walter discloses that the deep-drawn packaging film is a blister or strip film package in the electronics, data media, food, or pharmaceutical industry.

However, in the related art of packaging material with security features, Zeiter ('491) discloses a packaging material that has defined areas with one or more security features that are of holographic images or text ('491; Col. 2, lines 28-33). The security features taught by Zeiter may either be directly printed on or laminated onto the packaging film ('491; Col 3, lines 24-30). Zeiter teaches that the packaging forms may specifically be formed into packages such as push-through packs or blister packs, by stamping, scaling, deep drawing and/or stretch drawing ('491; Col 4, lines 14-24). Zeiter discloses that forgery-proof packaging or packaging material may serve as guarantee of origin, enabling the customer to recognize that the purchased item was actually manufactured and packaged by the desired manufacturer, as a guarantee that the item

has not been tampered with and is not a fake (*Col 1, lines 22-37*), which is of great importance especially for the pharmaceutical, foodstuffs, cosmetics, software industries (*Col 1, lines 11-21*).

The Examiner notes that blister packs taught by Zeiter may be in the form of a strip having multiple blisters, and therefore a strip pack, as is known in the pharmaceutical industry.

At the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the packaging film having at least one security feature as taught by Kaule in view of Walter to include blister films and strip packs as taught by Zeiter because the formation of in-mold security labels that are fixedly attached and integral with such blister films and strip pack materials will result in forgery-proof packaging or packaging that serve as a guarantee of origin, enabling the customer to recognize that the purchased item was actually manufactured and packaged by the desired manufacturer, as a guarantee that the item has not been tampered with and is not a fake, which is of great importance especially for the pharmaceutical, foodstuffs, cosmetics, software industries.

Additionally, it would have been obvious to one having ordinary skill in the art to modify the type of packaging material taught by Kaule in view of Walters to include blister and strip packs because such a modification to the form of the packaging material only requires a change in the shape and/or size of the material, where a change in size is generally recognized as being within the level of ordinary skill in the art, and the configuration is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration claimed was significant, see *MPEP 2144.04, IV*.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant provides two main arguments:

First, Applicant points out that the Examiner acknowledges that Kaule does not teach or suggest a UV-curable deep-drawable separation lacquer, on p. 5 of the remarks.

The Examiner respectfully points out that in par. 5 (p. 4) of the Office Action mailed 01/23/2009, the Examiner made of record that Kaule teaches a UV-curable lacquer, and only admits that Kaule does not specifically teach that the lacquer is "deep-drawable".

As clarified in the present rejections, the Examiner has made of record that the UV-curable lacquer taught by Kaule, absent evidence showing otherwise, is capable of being deep-drawn and thus meets the limitations of a UV-curable "deep-drawable" lacquer.

Second, Applicant argues that the security labels of Kaule are not regionally applied specifically to a packaging film.

These arguments are rendered moot in view of the new ground(s) of rejection, where Kaule teaches that the security features may be applied to any object and that it would be obvious to modify the object of Kaule with the packaging film and method of Walter, or alternatively, the labeled packaging material and method of Walter with the label of Kaule, for the reasons as discussed above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to APRIL C. INYARD whose telephone number is (571) 270-1245. The examiner can normally be reached on Monday - Thursday 8:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/  
Supervisory Patent Examiner, Art Unit 1794

APRIL C INYARD /A. C. I./  
Examiner, Art Unit 1794